

REMARKS

In the present Amendment, claims 2, 3, and 4 are amended and claims 7, 8, and 9 are new. Thus, upon entry of this Amendment, claims 1-9 are pending, of which claim 1 is independent.

Claim Rejections – 35 U.S.C. § 103(a)

The Office Action rejects claims 1-4 under 35 U.S.C. § 103(a) as unpatentable over PARK (U.S. Patent No. 5,460,818), in view of TANAKA (U.S. Patent No. 4,438,058), further in view of TAUB (U.S. Patent No. 3,900,433).

Applicants submit that, with respect to claim 1, the disclosures of PARK, TANAKA, and TAUB are inconsistent and one of ordinary skill would not combine the disclosures of these documents.

The Office Action notes that PARK does not disclose the use of a surfactant and relies on the disclosure of TANAKA for the use of a surfactant. The Office Action further notes that TANAKA does not describe impregnation conditions of a surfactant and relies on the disclosure of TAUB for time and pressure processing conditions.

Initially, Applicants respectfully submit that the resin beads disclosed by TANAKA are of polystyrene only (Col. 1, lines 5-8). Thus the beads are not similar to the olefinic polymer/monovinylidene aromatic polymer/compatibilizer blended resin beads of PARK. One of ordinary skill in the art would not be guided to incorporate a surfactant compatible with the resin

beads of TANAKA with the resin beads of PARK where the materials of the respective disclosures are different. Applicants submit that one of ordinary skill would not assume the same processing conditions would be appropriate even if one to substitute were the TANAKA resin beads for the PARK resin beads.

Applicants further note that the Office Action, in determining an amount of surfactant, remedies the problem of TANAKA and PARK being directed to two different materials by stating that "one in the art would have applied from within an amount which is disclosed to be suitable for its intended purpose by the prior art reference." However, Applicants submit that even if a surfactant is incorporated into the PARK resin beads, the Office Action does not establish that this hypothetical amount of surfactant would necessarily fall into the relevant range of the pending claims. Further, the Office Action does not set forth a reasonable expectation of success that the hypothetical amount of surfactant would be similarly effective when incorporated into the resin beads of PARK.

Applicants further submit that TAUB is incompatible with the disclosures of either TANAKA or PARK, as well as the present claims. Applicants respectfully submit that TAUB is directed to a process for making expandable styrene polymer particles which is not comparable to the method of the present claims.

For example, TAUB does not disclose the use of a surfactant as recited in the present claims. Rather, TAUB discloses the use of an impregnation aid incorporated into a blowing agent to achieve a better absorption of the blowing agent in the polystyrene (Col. 1, lines 41-47). The

impregnation aid is not comparable to the surfactant of the pending claims. Applicants further submit that the impregnation aids of TAUB, i.e., halogenated hydrocarbons such as dichlorotetrafluoroethane and dichlorodifluoromethane, are not of a chemical group of the surfactants of the claims nor would such impregnation aids be expected to have the ability to provide antistatic properties if implemented into the styrene-modified beads of the present application. Applicants submit that one of ordinary skill in the art would not have incorporated the temperature and pressure ranges of TAUB where the basic disclosure of TAUB is directed to a different type of process than either the disclosure of PARK or the processes reflected in the pending claims.

Applicants submit that the disclosures of PARK, TANAKA, and TAUB are incompatible for combination. Further, Applicants submit that even if the combination were made, the Office Action has not set forth a *prima facie* obviousness rejection by establishing that each and every element of the pending claims would be disclosed by the cited documents.

The Office Action also rejects claim 2 and further asserts that PARK in view of TANAKA and TAUB discloses impregnating the styrene beads with surfactant in an aqueous medium. The Office Action also rejects claim 3 and further asserts that TANAKA teaches using a cationic surfactant. The Office Action also rejects claim 4 and further alleges that the surfactant is in liquid suspension at 20 to 30 degrees Celsius (no document was cited for this assertion).

Applicants submit that claim 1 is not rendered obvious by the cited documents and is patentable over the cited documents for at least the foregoing reasons. Claims 2-4 depend from

and incorporate all the limitations of claim 1 and Applicants submit that these claims are similarly patentable over the cited documents. Thus, Applicants submit that the rejections of claims 2-4, reproduced above, are rendered moot. Applicants respectfully request withdrawal of the rejections based on the PARK, TANAKA, and TAUB documents and request that these claims be allowed.

The Office Action rejects claims 5 and 6 under 35 U.S.C. § 103(a) as unpatentable over PARK in view of TANAKA and TAUB, and further in view of HENN (U.S. Patent No. 5,563,178).

Applicants submit for at least the above-stated reasons claim 1 is not obvious over the cited documents. Applicants note that claims 5 and 6 depend from and incorporate all the limitations of claim 1 and submit that the foregoing discussion is similarly fully applicable to the rejections of claims 5 and 6. Applicants respectfully submit that the combination of PARK, TANAKA, and TAUB does not render claims 5 and 6 obvious; such a combination further in view of HENN also does not render claims 5 and 6 obvious.

Claim Rejections – 35 U.S.C. § 112, second paragraph

The Office Action rejects claims 2, 3, and 4 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter.

Specifically the Office Action finds insufficient antecedent basis for the term “pre-expanded”.

Claims 2, 3, and 4 are presently amended. Applicants submit that the claims as amended have sufficient antecedent basis and respectfully request withdrawal of these rejections.

CONCLUSION

For all the above reasons, it is respectfully submitted that all pending claims are patentably distinct over the documents employed in the rejection of record. Applicants request reconsideration and withdrawal of the rejections of record. Allowance of the application with an early mailing date of the Notices of Allowance and Allowability is therefore respectfully requested.

If there should be any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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